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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,005	01/20/2004	Ehud Cohen	A92.12-0040	1642
27367 7590 10/14/2008 WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3244				
EXAMINER NATNITHITHADHA, NAVIN				
ART UNIT		PAPER NUMBER		
3735				
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10/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,005

Applicant(s)

COHEN ET AL.

Examiner

NAVIN NATNITHADHA

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 277, 279-286, 288-301 and 317 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 277, 279-286, 288-301 and 317 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Final Drawing Review (PTO-849)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20080911
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. According to the Amendment, filed 08 August 2008, the status of the claims is as follows:

Claims 277, 279-286, 288-301, and 317 are previously presented; and

Claims 1-276, 278, 287, and 302-316 are cancelled.

Response to Arguments

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
3. Applicant's arguments, see Remarks, p. 7, filed 08 August 2008, with respect to the rejection of claims 277, 279-286, 288-301, and 317 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, have been fully considered, and are persuasive. The rejection of claims 277, 279-286, 288-301, and 317 has been withdrawn.
4. Applicant's arguments, see Remarks, pp. 8-9, filed 08 August 2008, with respect to the rejection of claims 277, 288, 291-301, and 316 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson, U.S. Patent No. 5,508,476 A ("Dickenson"), in view of Itoigawa et al, U.S. Patent No. 5,807,265 A ("Itoigawa"), have been fully considered, and are persuasive. Therefore, the rejection has been

withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

5. Applicant's arguments, see Remarks, pp. 10-11, filed 08 August 2008, with respect to the rejection of claims 279 and 317 under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claim 277 above, and further in view of Woodard et al, US 5,851,226 A ("Woodard"), have been fully considered, and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

6. Applicant's arguments, see Remarks, p. 12, filed 08 August 2008, with respect to the rejection of claims 280-285, 289, and 290 under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claim 277 above, and further in view of Skubitz et al, US 5,851,226 A ("Skubitz"), have been fully considered, and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

7. Applicant's arguments, see Remarks, p. 12-13, filed 08 August 2008, with respect to the rejection of claim 286 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Itoigawa, as applied to claims 277 above, and further in view of Delfino et al, US 6,129,658 A ("Delfino"), have been fully considered, and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

Inventorship

8. In view of the papers filed 26 August 2008, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding the following previously unnamed person as inventor of this application: Nir Betser.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 277, 279, 288, 291-301, and 317 are rejected under 35 U.S.C. 102(b) as anticipated by Dickenson or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dickenson in view of Silvian et al, U.S. Patent No. 6,522,920 B2 ("Silvian").

Claims 277, 279, 288, 291, 294, 297, 298, and 317: Dickenson teaches the following:

an apparatus 1, comprising:

circuitry 2;

a lead wire 8; and

a hollow tube 6, which is entirely electrically-conductive (made of conductive copper) and is soldered directly to the circuitry 2, and which hollow tube 6 is mechanically coupled to the lead wire 8 so as to be electrically coupled thereto (see col. 2, ll. 17-51), wherein the hollow tube is crimped to the lead wire 8, as as to be mechanically coupled thereto (see the junction between tube 6 and lead wire 8 in figs. 1 and 2), wherein a portion of the lead wire 8 is disposed within the hollow tube 6 (see the junction between tube 6 and lead wire 8 in fig. 2), wherein the hollow tube 6 is crimped to the portion of the lead wire 8 (see the junction between tube 6 and lead wire 8 in fig. 2); and

a electrode sensor 22 or active element 22.

Dickenson apparatus 1, which includes circuitry 2, is capable of being implanted in a patient's body and, thus, having "medical functionality" because of the small size of the apparatus 1.

In the alternative that Applicant argues that Dickenson does not teach the limitation "implantable circuitry, having a medical functionality, which is adapted to be placed in the patient", Silvian teaches implantable semiconductor circuits, i.e. insulated gate bipolar transistors (IGBT) 1-4 (see figs. 1-4) having medical functionality, which is adapted to be placed in the patient (see col. 2, l. 62, to col. 3, l. 61). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Dickenson's circuitry to be implantable as taught by Silvian because Dickenson explicitly states that the apparatus is directed to "mounting arrangements for

semiconductor devices" and in particular the circuitry "is concerned with a mounting arrangement, or package, for an insulated gate bipolar transistor (IGBT)", in which Silvian uses such a IGBT semiconductor circuit for medical purposes.

Claims 292, 293, 295, 296, and 299-301: These claims appear to be alternative species of the "implantable circuitry" that are not critical to Applicant's invention. Since Silvian teaches an electrode sensor 22, Silvian teaches some of the species groups, i.e. claims 291, 294, 297, and 298, and the generic claims 291 and 297.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 280-285, 289, and 290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Silvian, as applied to claim 277 above, and further in view of Skubitz et al, US 5,851,226 A ("Skubitz").

Claims 280-285, 289, and 290: Dickenson in view of Silvian does not teach the lead wire 274 comprises MP35N, platinum/iridium, alloys having low iron content (i.e. 1-60%, 1-40%, or 1-20% iron by weight), or silver and the connector is coated with gold or comprises steel. However, Skubitz teaches "outer conductor 55 may optionally comprise wires formed of a nickel-titanium alloy such as NITINOL.TM. [i.e. MP35N] , platinum, gold, silver, palladium, other noble metals, and other alloys [i.e. steel] or metals suitable for use in the human body. NITINOL.TM. may be purchased from Fort Wayne Metals of Fort Wayne, Ind." (see col. 16, ll. 51-62). In fact, Applicant's

disclosure, on page 7, lines 27-32, admits that "these materials have proven to be both safe and effective for many applications in the human body". Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Dickenson's lead wire 76 (or Weinand's lead wire 12) and hollow tube 80 to comprise the materials of claims 280-284 and 289 because these materials are well known in the art to be suitable materials for use in the human body, as stated by Skubitz (see col. 16, ll. 51-62).

11. Claim 286 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickenson in view of Silvian, as applied to claims 277 above, and further in view of Delfino et al, US 6,129,658 A ("Delfino").

Claim 286: Dickenson in view of Silvian does not teach that the hollow tube 76 has been treated with phosphoric acid. However, Delfino teaches using phosphoric acid solutions for treating implantable medical apparatuses (see col. 2, ll. 35-36). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to treat Dickenson's tube with phosphoric acid because Delfino discloses that "Metal-phosphate coating processes using phosphoric acid solutions are also known for depositing coatings of to prevent corrosion, lubricate, prolong the life of metal surfaces, and improve paint coating adhesion" (see col. 2, ll. 35-36).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The other patents cited in the PTO-892 teach subject matter related to the Applicant's claims. The Examiner suggests reviewing these patents before responding to the present Office Action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAVIN NATNITHITHADHA whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Navin Natnithithadha/
Patent Examiner, Art Unit 3735
10/08/2008